

Serial No. 10/827,174

Art Unit: 1762

Remarks

Claims 1-4 and 6-22 are currently pending in the above-captioned matter.

Claims 1-4 and 6-22 are rejected. After entry of this amendment, claims 1-4 and 6-22 remain pending, claims 1, 13 and 21 being independent. No new matter has been added. Support for the amendment to claim 1 is found in Example 1-3 and in claim 10.

Support for the amendment to claim 13 is found at page 4-5, paragraph [0009.] and at page 12, paragraph [0027.] of the specification. Remarks made herein are based on the claims as amended hereby.

35 USC §112 Rejections

Claim 22 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 22 is also rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

The Patent Office has indicated that these rejections are based upon lack of support in the specification for the added limitation of "a solid matter concentration of the lubricating coating ranges from 5 to 15 weight percent". Applicant respectfully draws the Examiner's attention to the language of claim 22, which states "...solid matter concentration of the ... processing liquid ranges from 5 to 15 weight percent." Support for this limitation is found in the Processing Liquids (Specification, page 13-15 and the Preliminary Amendment dated April 21, 2004, page 4 and 5) recited in the Examples.

The Patent Office has failed to establish a *prima facie* case of lack of support in the specification for the phrase range contained in claim 22. The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention on any ground is always upon the examiner. Adequate description under 35 U.S.C. §112, first paragraph does not require literal support for the claimed invention. Rather, it is sufficient if the originally-filed disclosure would have conveyed to one having ordinary

Serial No. 10/827,174

Art Unit: 1762

skill in the art that Appellant had possession of the concept of what is claimed. *Ex Parte Parks*, 30 USPQ2d 1234 (1993).

The table below shows the lubricant : inorganic salt ratio and the solid matter concentration of the processing liquid used in each Example and in Comparative Examples using a similar processing liquid, i.e. not a conversion coating.

Example	Lubricant : Inorganic Salt Ratio	Solid Matter Concentration of Processing Liquid	Processing Liquid
1	1.0	10 wt%	1
2	0.5	5 wt%	2
3	2.0	10 wt%	3
4	0.3	15 wt%	4
5	1.5	15 wt%	5
6	1.0	10 wt%	1
7	0.5	5 wt%	2
8	2.0	10 wt%	3
9	0.3	15 wt%	4
10	1.5	15 wt%	5
11	0.3	15 wt%	4
12	1.5	15 wt%	5
Comp. Ex. 1	0	10 wt%	6
Comp. Ex. 2	∞	10 wt%	7
Comp. Ex. 4	1.0	0.5 wt%	8

Examples 1-12 disclose processing liquids having solid matter concentrations in the range of 5-15 wt %. The lower end point of the range, 5 wt %, is specifically set forth in Examples 2 and 7, and the upper end point of the range 15 wt % is recited in Examples 4, 5 and 9 -12. Intermediate solid matter concentrations within the claimed range are disclosed in Examples 1, 3, 6 and 8.

Applicants respectfully submit that the specification need not recite each and every weight percent within the range to meet the requirement for adequate written description. To satisfy the written description requirement, possession may be shown in a variety of ways including description of an actual reduction to practice. MPEP 2163 (I.) One of skill in the art reading the Examples would see evidence that solid matter concentrations of 5 wt %, 10 wt% and 15 wt% were in Applicants' possession and would have sufficient information to conclude that solid matter concentrations in

Serial No. 10/827,174

Art Unit: 1762

between 5 and 15 wt %, were also within the scope of Applicants' invention.

Comparative Examples also support the claimed range where Comparative Example 4 has a 0.5 wt % solid matter concentration and, as shown in Table 1 of the specification, it does not provide sufficient lubricity. Applicants request that the rejections under 35 U.S.C. §112 be withdrawn.

35 USC §103 Rejections

Claims 1, 3-4, 8, 11 and 21-22 are rejected under 35 U.S.C. §103(a) as being unpatentable over Imai et al. (WO 99/64544).

Claims 1-4, 6, 8-11, 13-14 and 16-20 are rejected under 35 U.S.C. §103(a) as being unpatentable over WO 99/64544 (Imai et al) in view of U.S. Patent 4688411 (Hagita et al.).

Claims 7, 12 and 15 are rejected under 35 U.S.C. §103(a) as being unpatentable over WO 99/64544 (Imai et al) taken in view of U.S. Patent 4688411 (Hagita et al.) alone or when further taken in view of U.S. Patent 5282377 (Illig et al.).

Each of these rejections is traversed with respect to the claims as amended hereby. Independent claims 1, 13 and 21 each recite features that are neither taught nor suggested by these references. Specifically, claim 1 recites cleaning by electrolytic pickling that is not taught or suggested by the references. The cathodic and anodic pickling recited in claim 1 is an improvement over ordinary pickling which takes too long to work effectively in a continuous in-line process as claimed by Applicants. Hagita does not recognize this problem nor suggest the solution developed by Applicants. The rejection of claim 1, and the claims depending therefrom under 35 U.S.C. §103(a) should be withdrawn.

Regarding claim 13, which recites a processing liquid comprising inorganic salt and at least one lubricant selected from the group consisting of metal soaps, waxes, poly-tetrafluoroethylene, molybdenum disulfide, and graphite, in the absence of polymer different from (ii.), Applicants wish to first address the issue of adequate support under

Serial No. 10/827,174

Art Unit: 1762

35 U.S. C. §112. As discussed above, it is sufficient if the originally-filed disclosure would have conveyed to one having ordinary skill in the art that Appellant had possession of the concept of what is claimed. *Ex Parte Parks*, 30 USPQ2d 1234 (1993). None of the Examples contain polymer other than those recited in the lubricant portion of the claims. The specification states distinguishes the Imai reference by pointing out that in the lubricants formed in that invention "synthetic resins are used as the main component and thus they could not produce thorough lubricity under harsh processing conditions.....The present invention was developed to solve the problems encountered in the conventional technique." Page 5, paragraphs [0009.] and [0010.]. Thus, Applicants had the concept of making a lubricant for combination with an inorganic salt without the synthetic resins taught by Imai. Additionally, at page 12, paragraph [0027.], Applicants disclose that "polymers in the organic system", meaning organic polymers, may be used as binders. This component is disclosed as an optional additive, and hence may be omitted.

Imai requires the presence of synthetic resins such as polyvinyl alcohol, acrylic resins and urethane resins. It would not have been obvious to one of ordinary skill in the art at the time Applicants' invention was made to omit such substances. To omit the very first required component of Imai would destroy the reference, which is not permitted when combining references. As such, the rejection of claim 13 and the claims depending therefrom under 35 U.S.C. §103(a) should be withdrawn.

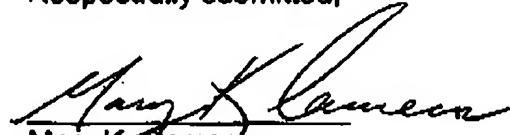
Likewise, where claim 21 now recites that the processing liquid consists of particular components that do not include the synthetic resins of Imai, that reference cannot be modified in an attempt to achieve the claimed invention without destroying the reference. Accordingly, the rejection of claim 21 and the claim depending therefrom under 35 U.S.C. §103(a) should be withdrawn.

Serial No. 10/827,174
Art Unit: 1762

Conclusion

Applicants request reconsideration in view of the amendments and remarks contained herein. Applicants submit that the claims are in condition for allowance and a notice to that effect is respectfully requested. Should the Examiner have any questions regarding this paper, please contact the undersigned.

Respectfully submitted,



Mary K. Cameron
(Reg. No. 34,789)
Attorney for Applicants
248-589-4672

Henkel Corporation
Patent Law Department
2200 Renaissance Boulevard, Suite 200
Gulph Mills, PA 19406

MKC/mkc